

### REMARKS

The Office Action mailed August 14, 2006 has been received and reviewed.

Claims 1 through 7 are currently pending in the application. Claims 1 through 7 stand rejected. Applicant has canceled claims 1 and 6, amended claims 2 and 3, and added claim 8.

Reconsideration of the above-referenced application is respectfully requested.

#### **1. *Informalities***

Substitute Specification. Several changes have been made to the specification to clarify certain concepts and information, including emphasis on use of a weight positioned at the base end to assist in a thrown trajectory. (See page 4, lines 25-26 of the specification.) Applicant submits that no new matter is presented in the corrections identified below, and that the replacement specification conforms to and is submitted pursuant to 37 C.F.R. § 1.125.

Claim Cancellation. Claims 1 and 6 have been cancelled from the application.

Claim Amendments. Claims 2 and 3 have been amended. The subject matter contained in the amended claims is properly supported in the specification and no new matter has been added.

Claim Additions. Claim 8 has been added to the application. The subject matter contained in the new claim is properly supported in the specification. In addition, no new matter is being set forth in this claim.

#### **2. *Claim Rejections – 35 U.S.C. § 112***

Claim 2 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Appropriate correction has been made.

#### **3. *Anticipation Rejections – 35 U.S.C. § 102(b)***

Claims 3-5 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Witt et al. (U.S. Patent No. 6,267,244, hereinafter referred to as “Whitt”). Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found,

either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

It is respectfully submitted that, under 35 U.S.C. § 102(b), amended independent claim 3 includes the subject matter of claim 6, now cancelled, and thus recites subject matter which is allowable over Witt. Witt teaches a bag for storing and dispensing cord which may include an annular support that can be affixed inside or outside the interior compartment of bag (310) by metal rivets (365). Col. 4, lines 19-23. However, Witt does not teach a bag with a weight coupled to the base end. To the contrary, Witt teaches a bag with an aperture 108 in a first end of the bag 106 and a second aperture 122 or slit in the fabric of the opposite end cover 110. (*see* Fig. 1 and Col 2, lines 40-42; 64-67). End cover 110 is not coupled to a weight that operates as a ballast to assist the bag to remain in an upward position and in a desired deployment trajectory when thrown, as is the weight coupled to the base end of the present invention

Witt does not teach a bag with a base end and an open end and having a weight coupled to the base end. Witt, therefore, does not anticipate each and every element of amended independent claim 1. Accordingly, it is respectfully submitted that, under 35 U.S.C. § 102(b), the subject matter recited in amended independent claim 3 is allowable over the subject matter described in Witt.

Claims 4-5 and 7 are each allowable, among other reasons, for depending directly from claim 3, which is allowable.

Based on the foregoing, Applicant respectfully submits that Witt does not anticipate any of the claims of the present invention. For these reasons, withdrawal of the 35 U.S.C. § 102(b) rejections of claims 3-5 and 7 is respectfully solicited.

#### **4. Claim Rejections -- 35 U.S.C. § 103(a)**

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable for being the obvious method of using the bag of Witt et al. (U.S. Patent No. 6,267,244, hereinafter referred to as "Whitt"). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and **the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.** *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Relating this language to the present case, it cannot be said that one ordinarily skilled in the art would consider amended claim 2 to be the obvious method of removing an extension cord from the bag for storing and dispensing cord described in Witt, as the invention of Witt does not contain or suggest the method of removing the extension cord by tossing the bag. Moreover, applying to the invention of Witt the method of dispensing the extension cord by tossing the bag, as disclosed in amended claim 2, would render the invention of Witt inoperative, thus removing the reasonable expectation of success in making the asserted combination.

Witt teaches that “[w]hen a length of cord 104 is needed, drawstring 114 is released to enlarge aperture 108. The desired length of cord is then withdrawn, leaving any remaining length of cord 104 conveniently stored and out of the way ...” Col. 2, lines 55-58. Leaving a significant length of cord inside the bag is the focus of Witt, as an annular support keeps the bag from collapsing when lying on its side. Col 3, lines 23-28. This is useful, because keeping the bag from collapsing eases the “insertion and extraction of [the] cord 104” and allows for the free circulation of the air between the loops of cord remaining inside the bag and prevents excess heat from building up within the bag. Col 3, lines 36-42.

It would be obvious to one having ordinary skill in the art that removing the cord from the Witt bag by tossing the storage bag, as disclosed in amended claim 2, would extract most, if not all, of the extension cord from the bag, thereby rendering the convenient storage and anti-collapsing features of the Witt bag inoperative. It appears that Applicant's own disclosure has been impermissibly employed in hindsight to provide a motivation or suggestion for the attempted combination of references.

Based on the foregoing, Applicant submits that the prior art does not render the claims of the present invention obvious. As such, Applicant respectfully requests that amended claim 2 of

the application be reconsidered and that the rejection under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Based on the foregoing, Applicant respectfully submits that the deficiencies in the application have been corrected and that the proposed claims are neither anticipated nor rendered obvious by the prior art references cited by the Examiner. As such, Applicant believes that the claims are now in a condition for allowance, and action to that end is respectfully requested.

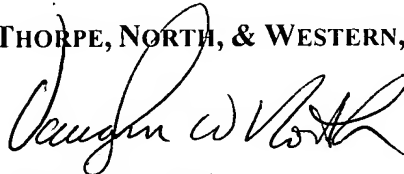
If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 20-0100.

DATED this 14th day of November, 2006.

Respectfully submitted,

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